

Remarks/Arguments

Claims 1 to 22 are pending.

The Office Action stated: that a request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection; that, since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office Action has been withdrawn pursuant to 37 CFR 1.114; and that applicants' submission filed on February 4, 2004 has been entered.

The Office Action stated that the objection to Claim 15 of record in the Office Action mailed November 10, 2003, page 3, paragraph 6, has been withdrawn due to applicants' amendment in the paper filed on February 4, 2004.

The Office Action stated that the 35 U.S.C. 112 rejections of Claims 15 to 22 of record in the Office Action mailed on November 10, 2003, pages 3 and 4, paragraph 7, have been withdrawn due to applicants' amendments in the paper filed on February 4, 2004. The Office Action stated that applicants' arguments regarding the 35 U.S.C. 112 rejections and the claim objection of record have been considered but are moot since the rejections have been withdrawn.

The Office Action stated that the 35 U.S.C. 102 rejections of Claims 15 to 16 and 22 as being anticipated by Bussard of record in the Office Action mailed on November 10, 2003, pages 4 and 5, paragraph 6, have been withdrawn due to applicants' amendments in the paper filed on February 4, 2004. The Office Action stated that applicants' arguments regarding the 35 U.S.C. 102 rejections

of Claims 15, 16 and 22 as anticipated by Bussard have been considered but are moot since the rejections have been withdrawn.

The Office Action stated that the 35 U.S.C. 103 rejections of Claims 17 to 21 over Bussard of record in the Office Action mailed on November 10, 2003, pages 6 to 9, paragraph 7, have been withdrawn due to applicants' amendments in the paper filed on February 4, 2004. The Office Action stated that applicants' arguments regarding the 35 U.S.C. 103(a) rejections of Claims 17 to 21 over Bussard have been considered but are moot since the rejections have been withdrawn.

Claims 15, 16 and 22 have been rejected under 35 U.S.C. 102(b) as being anticipated by Yamaguchi et al. (U.S. Patent No. 5,200,253). Applicants traverse this rejection.

The Office Action stated that Yamaguchi et al. anticipates a tube packaging laminate (Figures 16 and 17) having an appearance similar to a hologram. Applicants traverse this statement for several reasons. Within the field of patent law, a prior art reference can only anticipate a claim.

Figures 16 and 17 show tube packaging, so they cannot anticipate claimed laminates to be used to produce tube packaging. Figures 16 and 17 do not indicate that they involve laminates, in fact a single layer sheet is indicated by number 73a in Figure 17. (The detailed description in columns 11 and 12 are not indicated or shown in Figures 16 and 17.)

Figures 16 and 17 do not show anything that conveys that a hologram is present or that conveys that something similar to a hologram is present.

Columns 11 and 12 of Yamaguchi et al. state that holograms are present. Holograms are expensive and applicants' claimed invention achieves substantial reduction in such costs. One of the objections of applicants' claimed invention is to use an embossed design that provides an appearance similar to a hologram. Applicants do not claim holograms, therefore, Yamaguchi et al. does not anticipate applicants' claimed invention.

The Office Action stated that the tube packaging laminate consists of a multilayer material having a non-adhesive functional layer or sealant layer (reference number 116, Figure 24 or reference number 56, Figure 14) of polyethylene or polypropylene (col. 11, lines 6 to 12) and a thickness of 10 to 80 micrometers (col. 11, lines 16 and 17). Applicants traverse this statement. Figure 14 involves the fifth example of the hologram forming sheets of Yamaguchi et al. and Figure 24 involves the eighth example. The Examiner has throughout this anticipation rejection incorrectly taken pieces from separate "preferred embodiments" and tape them together to try to arrive at applicants' claimed invention. Section 102(b) requires disclosure of a claimed invention, not attempted scavenging of parts of separate embodiments to build the claimed invention. M.P.E.P. 2131 states:

"TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM"

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.... 'The identical invention must be shown in as

complete detail as is contained in the ... claim.'... The elements must be arranged as required by the claim, but this is not an *ipssissimis verbis* test, i.e., identity of terminology is not required."

Furthermore, Yamaguchi et al. is not anticipated because it only discloses actual holograms.

The thickness disclosed for Figure 14 cannot be carried over to Figure 24 because they involve separate preferred embodiments of Yamaguchi et al.

Layer 116 is an OP varnish layer so it cannot be a functional layer as defined in applicants claims – see page 4, lines 35 and 36.

Figure 24 cannot ever anticipate because it requires further layers 111, 118 and 117, that are excluded from all of applicants' claims. For example, where is paper sheet 117 included in Claim 15?

The Office Action stated that the laminate contains a lacquer coating (reference number 115, Figure 24) to insure a better adhesive between the metal layer and the functional layer (col. 8, lines 4 to 7). This information is of no import under this anticipation rejection because the embodiment of Figure 24 is not anticipatory (as explained above).

The Office Action stated that the metal layer (reference number 114, Figure 24) is made of aluminum (col. 17, lines 53 to 55) and has an embossed design completely or partly over the surface of a damask patter or a small worm design (Figure 24). The eight example of Yamaguchi et al., shown in Figure 24, produces a hologram, not an entity that has the appearance of a hologram. There is no anticipation.

The Office Action stated that the laminate further contains a multi-layered plastic layer which is transparent at in some regions made from a polypropylene embossed layer (reference number 112, Figure 24) and a polyethylene film having a thickness of 40 micrometers extruded onto the polypropylene (col. 17, lines 1 to 20), which because of the extrusion of the polyethylene film a layer of melt extrudate of polyethylene is inherently formed between the polypropylene and polyethylene layers. Applicants traverse this statement as being factually in error and is technically incorrect. The eighth example/embodiment only lays down one layer by extrusion lamination. The entire polyethylene layer being laid down by such extrusion technique is molten. As a result it is entirely a melt extrudate layer or a polyolefin layer, but it is not two separate layers (D and E) as required by applicants' claims.

Since layer 116 is an OP varnish layer, even if the Examiner were correct, there would be varnish layer 116, a melt layer and a polyolefin layer. Such, three layer sequence is clearly excluded by applicants' claims. There is no anticipation by Yamaguchi et al.

The Office Action stated that the plastic film may also optionally have a printing pattern on one side (Figures 22 and 23). This information does not provide anticipation.

This rejection should be withdrawn.

The Office Action stated that the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for

establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 17 to 21 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al. (U.S. Patent No. 5,200,253). Applicants traverse this rejection.

The Office Action stated that Yamaguchi et al. teaches all that is claimed in Claims 15 to 22 as shown above, except the thickness of the lacquer, metal foil, and melt extrudate layers. Applicants traverse this statement as being factually incorrect as shown above. Furthermore, note that the Examiner only rejected Claims 15, 16 and 22 under Section 102(b).

The Examiner has not factually established in the record that Claims 15, 16 and 22 are *prima facie* obvious. That being so, the Examiner's attempt to show obviousness of dependent Claims 17 to 21 fails.

The Office Action stated that one of ordinary skill in the art would have recognized that section of the thickness of the layers would be accomplished through routine experimentation depending on the intended end result of the tube packaging laminate. Applicants traverse this statement as being mere

speculation and hindsight. Without a showing of anticipation or obviousness of independent Claim 15, there can be no obviousness of dependent Claims 17 to 20.

The Office Action stated that, therefore, it would have been obvious to one having ordinary skill in the art at the time the applicants' invention was made to select the thickness of the lacquer, metal foil and extrudate layers of Yamaguchi et al. within the claimed ranges, in order to form a desired wall thickness for the tube packaging, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. Applicants traverse this statement as being factually unsupported speculation. Section 103(a) requires facts, not speculation. Claim 15 is not anticipated or obvious, so none of the dependent claims are anticipated or obvious.

The Office Action stated see *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). This decision supports applicants' position. Yamaguchi et al. does not suggest "proportional balancing" – the Examiner has even had to assert that experimentation would be required (which is certainly not prior art suggestion) by one of routine skill in the art [who has nothing to do with Section 103(a)].

This rejection should be withdrawn.

Claims 15 to 22 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Touhsaent (U.S. Patent No. 5,013,353) in view of Kay (U.S. Patent No. 5,851,615). Applicants traverse this rejection.

The Office Action stated: that Touhsaent teaches a packaging laminate which is used to overwrap food and non-food products in the shape of a tube, and see the abstract.

The Office Action stated that the laminate consists of a multilayered material having a layer structure of at least one functional layer of plastic as described in Touhsaent as a low temperature sealable coating, the function being a sealable layer. Applicants' claimed invention is patentable/unobvious as whole.

The Office Action stated that the functional layer contains at least one polyethylene (col. 1, lines 60 to 65); and that the non-adhesive functional layer also contains a lacquer coating (col. 2, lines 8 to 14). This statement is not a complete description of those portions of Touhsaent. Touhsaent states:

"Optionally, a printed ink pattern may be applied to the surface of the sealable coating on the metal later or on the coated or uncoated surface on the other side of the film, with an overlacquer applied to the surface containing the printed pattern to protect the pattern from damage. Also, optimally, another film may be laminated to any surface of the metallized film which does not contain an overlacquer." [Emphasis Supplied] [Column 2, lines 8 to 14]

The overlacquer in Touhsaent is only applied over a printed ink pattern. In applicants' claimed invention a printed ink pattern is only on the outer surface of lacquer coating (D) so Touhsaent directs away from applicants' claimed invention.

The Office Action stated that the laminate further consists of a metal foil or metal deposit layer (Figure 1) composed of aluminum (col. 4, lines 26 to 30).

The overlacquer coating of Touhsaent has to have a printed ink pattern between it and the metal foil/deposited layer which arrangement is excluded from applicants' claimed invention.

The Office Action stated that on the opposite side of the metal deposit layer from the low temperature sealable coating is a multi-layering plastic layer comprising surface-treated polymer skin layer, melt extrudate, and a polymer core layer. Applicants claimed invention excludes a surface-treated polymer skin layer between the metal layer and the melt extract, so Touhsaent cannot result in applicants' claimed invention.

The Office Action stated that the polymer core later is a non-adhesive film containing polyethylene (col. 3, lines 40 to 42). Applicants' claimed invention is patentable/unobvious as a whole.

The Office Action stated: that the skin layer is also made from polyethylene (col. 3, lines 24 to 28) and is extruded onto the core layer (col. 3, lines 10 to 12); and that, therefore, where the core layer and skin layer meet is a melt extrudate of polyethylene caused by extruding the polyethylene onto the core layer. The arrangement of layers set out in this statement puts Touhsaent outside of applicants' claimed invention. Removal of the nonallowable layer from Touhsaent would destroy the Touhsaent invention so that cannot be done in the search for applicants' claimed invention.

The Office Action stated that optionally a printed ink pattern may be applied to the coated or uncoated surface opposite the sealable coating layer of the film (col. 2, lines 8 to 14). This statement is not complete as Touhsaent requires an overlacquer coating on any such optional printed ink pattern, which means that, when Touhsaent uses a printed ink pattern, Touhsaent is automatically outside of applicants' claims.

The Office Action stated that Touhsaent fails to explicitly teach having an embossed design over whole or part of the surface of the metal foil layer. This statement is incorrect because, as noted herein, Touhsaent has other differences from applicants' claimed invention that prevents Touhsaent from resulting in or suggesting applicants' claimed invention. The Examiner has not provided any reasons, facts, etc., that would cause one ordinarily skilled in the art to ignore any of the requirements of Touhsaent in the quest for applicants' claimed invention.

The treated surface of the "surface treated polymer skin layer" of Touhsaent that is contact with the metal layer comprises a separate layer. Touhsaent states:

"Before applying the metal, primer or polymeric, film-forming coatings to the surfaces of the film substrate, as described hereinafter, the surfaces intended to receive the metal coating and optionally the opposite surface are treated to insure that the coatings will be strongly adherent to the film substrate, thereby eliminating the possibility of the coatings peeling or being stripped from the film. This treatment can be

accomplished by employing known prior art techniques such as for example, film chlorination, i.e., exposure of the film to gaseous chlorine, treatment with oxidizing agents such as chromic acid, hot air or steam treatment, flame treatment, corona discharge treatment, and the like.

Flame or corona discharge treatment of the surfaces is preferred in the production of the films of this invention." [Emphasis Supplied] [Col. 4, lines 1 to 14]

"Subsequently the HDPE skin layer was flame treated...." [Example, Col. 8, lines 5 and 6]

"In accordance with this invention, a metallized multilayer film suitable for packaging applications is provided comprising a film substrate having in cross-section a polymer, e.g., polypropylene homopolymer, core layer, on at least one surface of which is a skin layer of a polymer having a lower melting temperature than the polymer of the core layer, the exposed surface of such skin layer having been treated, e.g., flame or corona discharge treated, prior to coating to increase its adherence to other materials, such film substrate containing a metal layer, e.g., of aluminum, deposited on said treated skin layer surface...." [Emphasis Supplied] [Col. 1, lines 51 to 61]

"A metallized multilayer packaging film comprising a film substrate having a polymer core layer on at least one surface of which is a first polymer skin layer having a lower melting temperature than that of said core layer, the exposed surface of said first skin layer having been treated

prior to coating to increase its adherence to other materials, said film substrate containing a metal deposit obtained by a method selected from the group consisting of vacuum deposition and sputtering on said treated first skin layer surface....” [Emphasis Supplied] [Claim 1, lines 1 to 9]

“A metallized multilayer film comprising a film substrate having a polymer core layer, e.g., a polypropylene homopolymer (OPP), on at least one surface of which is a polymer skin layer having a lower melting temperature than that of said core layer, the exposed surface of skin layer having been treated, e.g., flame or corona discharge treated, prior to coating to increase its adherence to other materials, the film substrate containing a metal deposit, e.g., aluminum, coated on the treated surface of the polymer skin layers,....” [Abstract, lines 1 to 10]

The surface temperature of the polymer skin layer produces a separate surface layer that is not the same as the polymer skin layer and that is located between the metal layer and the polymer skin layer. This separate surface layer resulting from the surface treatment is a critical feature of the Touhsaent invention and cannot be eliminated without destroying the Touhsaent invention. This mandatory separate surface layer is excluded by applicants' claimed invention. Accordingly, the combination of Touhsaent and Kay cannot result in applicants' claimed invention.

The Office Action stated that, however, Kay teaches that a surface relief structure is embossed into a lacquer layer (col. 3, lines 28 to 35) which has a metal deposit layer of aluminum coated on the lacquer layer (col. 3, lines 5 to

12), in order to generate an optically variable light effect such as a regular diffraction grating or a mosaic of diffracting gratings, such as, a damask pattern or small worm design (col. 3, lines 5 to 21), in order to render the packaging film tamperproof. This statement is not a full recitation of the required components of the Kay invention.

The Office Action stated see the abstract. Kay states:

"A tamper indicating security item such as a shrink wrap seal comprises a substrate including an optically variable effect generating structure such as an embossed hologram. Each surface of the substrate carries an adhesive having a strength that after the substrate has been adhered to a surface it cannot be removed without damaging the optically variable effect generating structure." [Emphasis Supplied] [Abstract, lines 1 to 7]

See also, for example, Claim 1, column 2, lines 13 to 22, 29 to 31 and 62 to 67, column 4, lines 17 to 23, column 6, lines 3 to 33, column 7, lines 5 to 16, and Figure 1 of Kay. The tamper indicating security item of Kay requires at least one surface that is an adhesive layer, that is not covered by a reasonable layer. Elimination of such required uncovered adhesive surface would destroy the Kay invention. Both surface layers of applicants' claimed invention must be non-adhesive layers. The combination of Touhsaent and Kay means that such combinations must have at least one surface that is an uncovered adhesive – the result is not applicants' claimed invention. The Examiner has not shown why such critical feature of the Kay invention can be eliminated in combining

Touhsaent and Kay in the quest for applicants' claimed invention. Applicants' claimed invention is unobvious.

The Office Action stated that one of ordinary skill in the art would have recognized that metallized packaging films have an embossed design over whole or part of the surface of the metal foil layer, in order to render the packaging film tamperproof, as taught by Kay. Application of Kay to Touhsaent would destroy the Touhsaent invention as Touhsaent does not seek to adhere it laminate to a product and a heat shrinkable film.

The Office Action stated that, regarding the thickness of the individual layers in Claims 17 and 21, one of ordinary skill in the art would have recognized that the optimum thickness for the layers of the laminate would be determined through routine experimentation depending on the intended end result of the laminate. Applicant traverses this statement. Section 103(a) requires facts, not speculation as to what so called routine experimentation might or might not achieve.

The Office Action stated that, therefore, it would have been obvious to one having ordinary skill in the art at the time applicants' invention was made to form the metal foil layer of Touhsaent with an embossed design over the whole or part of the surface, in order to render the packaging film tamperproof, as taught by Kay. Applicants traverse this statement. The Examiner has not factually shown in the record the necessary motivation for one ordinarily skilled in the art to combine Touhsaent and Kay in the search for applicants' claimed invention. The opposite is the actual situation as both rejection references direct away from

applicants' claimed invention. Furthermore, the combined rejection references do not result in applicants' claimed invention. The Examiner has not established why any of the required features, teachings, etc., of the rejection references can be ignored and discarded in the search for applicants' claimed invention.

The Examiner has not carried his burden of proof. The Examiner also has not factually established in the record a prima facie showing of obviousness.

This rejection should be withdrawn.

Reconsideration, reexamination and allowance of the claims are requested.

Respectfully submitted,

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